



COPY MAILED

Paper No. 6

BURNS DOANE SWECKER & MATHIS LLP
POST OFFICE BOX 1404
ALEXANDRIA VA 22313-1404

JUL 12 2001

OFFICE OF PETITIONS
A/C PATENTS

In re Application of
Phillips & Wong
Application No. 09/679,398
Filed: October 3, 2000
Attorney Docket No. 032001-011
For: HIERARCHICAL STORAGE
ARCHITECTURE FOR RECONFIGURABLE
LOGIC CONFIGURATIONS

:
: DECISION REFUSING
: STATUS UNDER
: 37 CFR 1.47(b)
:
:

This is in response to the petition under 37 CFR 1.47(b), filed May 7, 2001 (certificate of mailing date April 30, 2001).

The petition is dismissed.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on October 3, 2000 without an executed oath or declaration. Accordingly, on November 29, 2000, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on May 7, 2001 (certificate of mailing date April 30, 2001), a petition for a three month extension of time and small entity fee, a declaration executed by Charles Fox, the president of Chameleon Systems, Inc. (Chameleon), which was the employer of the non-signing inventors, a small entity surcharge, the petition fee, and the instant petition were filed. A declaration of facts of Joseph P. O'Malley, an attorney representing Chameleon, accompanied the petition. The petition sets forth the last known address of each non-signing inventor. Attorney O'Malley explains in his declaration that the complete application papers were received at joint inventors Phillips' and Wong's last known addresses, but each did not respond to the request that he sign the oath or declaration for the patent application.

A grantable petition under 37 CFR 1.47(b) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration;
- (2) an acceptable oath or declaration;
- (3) the petition fee;
- (4) a statement of the last known address of the non-signing inventor;
- (5) proof of proprietary interest; and
- (6) proof of irreparable damage.

Applicant lacks item (2) set forth above.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. The declaration signed by Mr. Fox does not set forth any information of the inventors. Mr. Phillips' and Mr. Wong's citizenship, address, residence and post office address are not listed on the declaration. An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the Rule 1.47 applicant on behalf of the non-signing inventors is REQUIRED. See MPEP 409.03(b).

Regarding finances, petitioner submitted a check for \$630, although the amount of the check as stated in the petition was \$640.00. The allocation of the check was as follows: \$130.00 for the petition to the Commissioner, \$445.00 for the small entity three month extension of time, and \$65.00 for the small entity surcharge for filing a late declaration. However, when petitioner filed the above-identified application, petitioner paid large entity fees. Until the Office is notified otherwise, petitioner remains a large entity.

Therefore, petitioner should have paid \$130.00 for the surcharge for filing a late declaration and \$1,390.00 for a four month extension of time.¹ The Office finance department charged petitioner \$10.00 to account for the \$10.00 discrepancy in the submitted check. Then the Office finance department charged petitioner \$510.00 for the large entity three month fee when it should have charged petitioner for the large entity four month fee. Pursuant to petitioner's authorization, deposit account No. 02-3800 will be charged an additional \$ 500.00, which is the balance due on the large entity four month extension of time fee.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, D.C. 20231

¹ Petitioner must purchase a four month extension of time because petitioner filed the instant petition on certificate of mailing date April 30, 2001. A three month extension of time from November 29, 2000 would only cover up to April 29, 2001.

By facsimile: (703) 308-6916
Attn: Special Program Law Office

By hand: Special Program Law Office
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

Telephone inquiries should be directed to Petitions Attorney E. Shirene Willis at (703) 308-6712.



E. Shirene Willis
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy